In re Application of Kiff
Application No. 10/706,807

REMARKS

Substitute Declaration

Applicant respectfully requests entry of the substitute declaration and power of attorney enclosed herewith.

The Pending Claims

Claims 14-17 and 19-21 currently are pending in the application.

Summary of the Office Action

The Office Action rejects claim 14 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,494,925 (Child et al.) (hereinafter "the Child '925 patent").

The Office Action also rejects claim 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 4,353,706 (Burns, Jr. et al.) (hereinafter "the Burns '706 patent").

The Office Action further rejects claims 15-17 under 35 U.S.C. § 103(a) as allegedly unpatentable over the Child '925 patent or the Burns '706 patent.

The Office Action rejects claims 19-21 under 35 U.S.C. § 103(a) as allegedly unpatentable over the Burns '706 patent alone or the Child '925 patent in view of the Burns '706 patent.

Discussion of the Section 102 and 103 Rejections

With respect to the Section 102 rejection over the Child '925 patent, the Office Action asserts that Example 2 of the Child '925 patent discloses the method recited in pending claim 14. However, Applicant notes that the description of Example 2 set forth in the Child '925 patent states that "the carpet was dyed with a solid shade applicator ... before the application of the fiber degrading composition and the print pastes" (the Child '925 patent at col. 9, lines 44-47). As would be understood by those of ordinary skill in the art, the "dyed" carpet referred to in this example would have had the dye(s) applied and fixed thereto to produce the "dyed" carpet. Accordingly, Applicants respectfully submit that Example 2 does not disclose a method in which an unfixed dye is introduced into the yarns, the fabric is then etched with a yarn-degrading composition, and the dye is then fixed. Thus, the pending claims cannot properly be considered anticipated by the Child '925 patent.

Furthermore, as previously noted by Applicant, the Office Action fails to identify any teaching or suggestion which would have motivated one of ordinary skill in the art to modify the method disclosed in the Child '925 patent in such a way as to arrive at the method recited in the pending claims. In particular, Applicant submits that the Office Action has failed to identify any teaching or suggestion that would have motivated one of ordinary skill in the art to modify the sequence of applying the dye and fiber degrading composition disclosed in the Child '925 patent in such a way as to arrive at the method recited in the pending claims. Therefore, the subject matter of the pending claims cannot properly be considered obvious over the Child '925 patent alone.

As for the Burns '706 patent, the Office Action acknowledges that the reference fails to disclose the particular method recited in the pending claims, but asserts that it would have been obvious to one of ordinary skill in the art to apply the dye either before or after the fiber degrading composition is applied. In support of this assertion, the Office Action states that the "motivation to do so would be to produce various aesthetic effects and/or to avoid mixing of the components" (the "Office Action" dated November 21, 2005 at page 3). However, as for the first proffered motivation, Applicant respectfully submits that the Burns '706 patent does not suggest that such aesthetic effects would result from varying the order in which the dye and fiber degrading composition are applied, and the Office Action does not identify any other source for such teaching. Therefore, it would appear that this supposed motivation could only be arrived at after a hindsight reconstruction of the claimed invention using Applicant's disclosure as a blueprint for selecting and selectively modifying the identified prior art.

As for the second proffered motivation, Applicant notes that the Burns '706 patent teaches that the dye and fiber degrading composition are applied together "so that the color appears in perfect register where the fiber degrading composition has been selectively applied" (see, e.g., the Burns '706 patent at col. 6, lines 25-29). So, this alleged motivation identified in the Office Action is in direct conflict with the express teachings of the Burns '706 patent because the separate application of the dye and fiber degrading composition could hinder the desired registering of the dyed and degraded areas of the fabric. Accordingly, Applicant submits that the invention defined by the pending claims cannot properly be considered *prima facie* obvious over the Burns '706 patent.

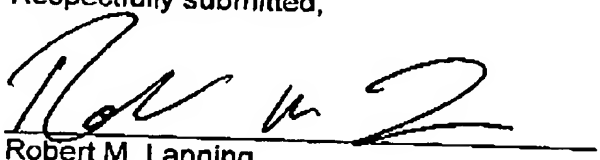
Finally, Applicant submits that the subject matter recited in the pending claims cannot properly be considered obvious over the combination of the Child '925 and the Burns '706 patents. As noted above, the Office Action fails to identify any teaching or suggestion which would have motivated one of ordinary skill in the art to modify the sequence of applying the dye and fiber degrading composition disclosed in the Child '925 patent in such a way as to arrive at the method recited in the pending claims. The Office Actions also fails to properly identify any teaching or suggestion which would have motivated one of ordinary skill in the art to modify the method disclosed in the Burns '706 patent in such a way as to arrive at the method recited in the pending claims. Therefore, both references fail to teach or suggest the particular method or sequence of steps recited in the pending claims. In view of this fact, the combination of the Child '925 and the Burns '706 patents must also fail to teach or suggest the method recited in the pending claims. Therefore, Applicant respectfully submits that the subject matter recited in the pending claims cannot properly be considered *prima facie* obvious over the combination of the Child '925 and the Burns '706 patents.

The section 102 and 103 rejections over the Child '925 and the Burns '706 patents, therefore, should be withdrawn.

Conclusion

In view of the foregoing, the application is considered in proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone interview would expedite prosecution of the instant application, the Examiner is invited to call the undersigned.

Respectfully submitted,



Robert M. Lanning
Reg. No. 57,121
MILLIKEN & COMPANY, M-495
P.O. Box 1926
Spartanburg, SC 29304
Telephone: (864) 503-1537
Facsimile: (864) 503-1999

Date: May 4, 2006